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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,070	03/09/2005	Toshihiko Sugano	266450US0PCT	6948

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EXAMINER

HAILEY, PATRICIA L

ART UNIT PAPER NUMBER

1755

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/527,070

Applicant(s)

SUGANO ET AL.

Examiner

Patricia L. Hailey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 13 is/are rejected.
- 7) ☐ Claim(s) 12 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/1/06</u> | 6) <input type="checkbox"/> Other: _____ |

Applicants' remarks and amendments, filed on May 24, 2006, have been carefully considered. Claim 2 has been canceled, and new claims 12-14 have been added.

Claims 1 and 3-14 are now pending in this application.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Document was filed on March 9, 2005.

New Ground of Rejection

2. Applicant's arguments with respect to claims 1-11, pending in the previous Office Action, have been considered but are moot in view of the new ground(s) of rejection.

The following New Ground of Rejection is being made in view of the newly discovered reference to Kojoh et al. (U. S. Patent No. 6,753,378).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 3-11, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Kojoh et al. (U. S. Patent No. 6,753,378).

Kojoh et al. disclose a magnesium-supported titanium catalyst system (useful for preparing by polymerization or copolymerization of an olefin having 2 to 20 carbon atoms; see col. 6, lines 9-14; considered to read upon **claim 11**) comprising a solid titanium catalyst component containing titanium, magnesium, and halogen as essential ingredients, an organometallic compound catalyst component, and, if necessary, an electron donor. See col. 6, lines 18-23 of Kojoh et al. (considered to read upon components (A), (B), and (E) in **claims 1, 4, 6, and 7**).

Examples of the electron donor include acid amides, such as N,N-dimethylacetamide, N,N-diethylbenzamide, and N,N-dimethyltoluamide (considered to read upon component (C), general formula (1) in **claim 1**, as well as the limitation of **claim 13**), organic acid esters, such as phthalic acid diesters, polyethers wherein the atoms present between the ether bonds can be silicon, etc. The electron donors can be used in combination of two or more kinds. See col. 9, line 1 to col. 55 of Kojoh et al., as

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well as col. 15, lines 20 to col. 16, line 35; this latter disclosure includes exemplary organosilicon electron donors (considered to read upon **claims 3 and 8-10**).

Examples of the organometallic compound include organoaluminum compounds, see col. 13, line 21 to col. 14, line 31 of Kojoh et al. (considered to read upon **claim 5**).

In view of these teachings, Kojoh et al. anticipate claims 1, 3-11, and 13.

Allowable Subject Matter

5. Claims 12 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

Kojoh et al. do not teach or suggest the limitations of claims 12 and 14, with respect to general formula (2) recited in claim 1.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Abe et al. (U. S. Patent No. 5,451,642) disclose a modifier that reads upon claims 12 and 14, said modifier being a component in a thermoplastic resin composition. See col. 20, lines 11-50. Although this reference discloses a catalyst

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comprising a magnesium compound, a titanium compound, an organoaluminum compound, and further comprising an electron-donating compound (col. 6, line 32 to col. 8, line 37), the reference does not teach or suggest that the modifier is a catalyst component.

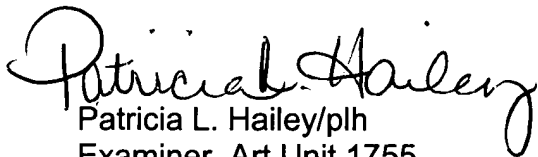
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Patricia L. Hailey/plh
Examiner, Art Unit 1755
September 21, 2006


J.A. LORENGO
SUPERVISORY PATENT EXAMINER